

REMARKS

The RCE Transmittal filed concurrently herewith is noted. The present amendments and arguments constitute the necessary Submission for this RCE Transmittal; and, in view of the RCE Transmittal, entry of the present amendments is a matter of right.

In the concurrently filed RCE Transmittal, Applicants have requested a suspension of action on the above-identified application under 37 CFR 1.103(c), for a period of three (3) months. This request for suspension of action is renewed herein. It is noted that the fee under 37 CFR 1.17(i) is being submitted herewith; and, accordingly, it is respectfully submitted that the requested suspension of action is to be granted.

By the present amendments, Applicants are amending claims 26 to recite the "vertical" plate, rather than the third plate, consistent with recitation in claim 1 that at the end portion of the hollow frame member, the hollow frame member includes a "vertical plate". In view of this amendment to claim 26, it is respectfully submitted that the rejection of claim 26 under the second paragraph of 35 USC 112, set forth on page 2 of the Office Action dated July 27, 2007, is moot.

Applicants respectfully traverse the rejection of their claims 23-25 under the first paragraph of 35 USC 112, as failing to comply with the written description requirement. Contrary to the conclusion by the Examiner, it is respectfully submitted that Applicants' disclosure as originally filed reasonably conveys to one of ordinary skill in the art that the present inventors, at the time the application was filed, had possession of the claimed invention including wherein the width and height of the raised portion is "substantially" uniform, as well as recitation of abutted portions of the hollow frame members extending in a direction "substantially" perpendicular to the thickness direction. In this regard, the Examiner's attention is respectfully

directed to In re Mattison, 184 USPQ 484 (CCPA 1975), discussing use of the word “substantially”. It is respectfully submitted that circumstances as discussed in Mattison correspond to present circumstances, such that use of the word “substantially” is proper.

In connection with the rejection under the first paragraph of 35 USC 112, it is respectfully submitted that reading Applicants' original disclosure as a whole, there is no criticality set forth in Applicants' original specification or drawings that the height and width of the raised portion must be “exactly” uniform, or that the abutted portion of the frame members extend in a direction “exactly” perpendicular to the thickness direction of the hollow member. As can be appreciated from Applicants' original disclosure as a whole, the raised portion has a specific function (e.g., of providing material to fill in any gaps between the abutting members, which gaps could cause indentations during the friction stir welding where said raised portion is not provided); and the direction that the abutted portion extends defines positioning of the hollow frame members relative to a thickness direction of the recited hollow frame member. Taking Applicants' disclosure as a whole, it is respectfully submitted that one of ordinary skill in the art, as of the filing date of the above-identified application, would have known that Applicants contemplated as part of their invention where the width and height of the raised portion are not only exactly, but also “substantially” uniform, and where the abutted portion extends in a direction not only exactly, but also “substantially”, perpendicular relative to the thickness direction of the hollow frame member (i.e., that there is no requirement that the width and height of the raised portion be completely uniform, or that the abutted portion of the frame members extends in a direction exactly perpendicular to the thickness direction), and thus the present disclosure satisfies the description requirement of the first paragraph of 35 USC 112. Especially in connection with technologies as in the present invention,

including relatively large members formed, e.g., by extrusion, one of ordinary skill in the art at the time of the present invention would have known, from Applicants' original disclosure, that Applicants contemplated that various dimensions could be "substantially" uniform, and the abutted portion could be "substantially" perpendicular, as in the present claims, such that the original disclosure satisfies the description requirement of the first paragraph of 35 USC 112, in connection with the subject matter claimed in claims 23-25.

Even were the Examiner to be correct that the description in the specification is narrower than that in claims 23-25, this does not in and of itself mean that there has been a failure to fulfill the description requirement in the first paragraph of 35 USC 112. See In re Smythe, 178 USPQ 279 (CCPA 1973). The test is whether the application as originally filed clearly conveyed in any way to those skilled in the art to whom it is addressed, the information that Applicants invented the recited structure. Especially in view of functions of the structure as in Applicants' original disclosure and guidance provided to one of ordinary skill in the art in connection therewith, and again noting that Applicants do not attach criticality that the height and width of the raised portion must be "exactly" uniform and that the abutted portion must extend in a direction "exactly" perpendicular to the thickness direction, it is respectfully submitted that Applicants provide sufficient description to satisfy the description requirement of the first paragraph of 35 USC 112.

Attention is respectfully directed to, for example, the sole full paragraph on page 14 of Applicants' specification. This disclosure, in connection with Fig. 14, discloses face plates 93, 93 supported by vertical plates 96, 96; and states that "[i]n this example 2, the vertical plates 96 are virtually perpendicular to the face plates 93, 94"; and that the "face plates 93, 94 are provided with raised portions 37a, 38a similar to the ones shown in Figure 7". Note especially reference to the vertical

plates being “virtually” perpendicular to the face plates 93, 94. See also page 5, lines 16-20, of Applicants’ specification. In other portions of Applicants’ specification, Applicants refer to the “vertical” plates 96. As can be seen therefrom, the feature need not be exact. Correspondingly, it is respectfully submitted that one of ordinary skill in the art would have known that the uniformity of the height and width of the raised portions could be “substantially” uniform, and that the abutted portion of the hollow frame member and the another hollow frame member can extend in a direction “substantially” perpendicular to the thickness direction of the hollow frame member.

In the second paragraph on page 6 of the Office Action dated July 27, 2007, the Examiner agrees that Applicants have set forth no criticality in their disclosure for “exactly” uniform or “exactly” perpendicular. The Examiner then says that Applicants go on to argue “that because of this, [Applicants] should be allowed to claim the broad range of substantially uniform and substantially perpendicular”. Applicants are not arguing that merely because the disclosure does not use the word “exactly”, that they should be able to recite “substantially” in their claims. It is respectfully submitted that taking Applicants’ disclosure as a whole, as required under the first paragraph of 35 USC 112, such disclosure establishes that Applicants contemplated as part of their invention that height and width of the raised portion can be “substantially” uniform, and that the abutting portion can be “substantially” perpendicular to the thickness direction.

Applicants again respectfully direct attention to disclosure of “virtual” perpendicularity of vertical plates to the face plates. Again, it is respectfully submitted that one of ordinary skill in this particular art would have known that Applicants contemplated as part of their invention wherein there was “substantial”

uniformity and "substantial" perpendicularity. Especially in view thereof, the description requirement of the first paragraph of 35 USC 112, is satisfied.

The contentions by the Examiner bridging pages 6 and 7 of the Office Action dated July 27, 2007, and in particular the contention by the Examiner that "substantially" is interpreted to encompass a broad spectrum of limitations "near and far from the actual or exact description" is noted. It is respectfully submitted that this is an unreasonable interpretation, particularly in view of In re Mattison, supra.

Applicants respectfully submit that all of the claims presented for consideration by the Examiner patentably distinguish over the teachings of the references applied by the Examiner in rejecting claims in the Office Action dated July 27, 2007, that is, the teachings of Japanese Patent Document No. 2-246863 (designated by the Examiner as Mochizuki, et al.), and of International (PCT) Publication No. WO 95/26254 (Midling, et al.), under the provisions of 35 USC 103.

It is respectfully submitted that the references as applied by the Examiner would have neither taught nor would have suggested such hollow frame member as in the present claims, having, at the end portion of the hollow frame member, a raised portion of the hollow frame member projecting to an outer side in a thickness direction of the hollow frame member from one side face of the hollow frame member, the raised portion being integrally provided on the end portion of the hollow frame member, and extending beyond the one side face in the thickness direction, the hollow frame member being adapted to be used in friction stir welding and the raised portion being adapted to have a rotary tool inserted therein in the thickness direction thus to carry out the friction stir welding; and the hollow frame member also having at the end portions thereof a vertical plate, wherein the vertical plate is located such that the rotary tool is above the vertical plate and the vertical plate supports a load during the friction stir welding; and wherein, during the friction stir

welding, material of the raised portion of the hollow frame member fills any gaps, between the hollow frame member and another hollow frame member to be welded to the hollow frame member, which exist when these hollow frame members abut each other. See claim 1; note also claim 2.

In addition, it is respectfully submitted that the applied references would have neither disclosed nor would have suggested such a hollow frame member as in the present claims, having a first plate, a second plate substantially in parallel to the first plate and a third plate connecting the first and second plates, with the raised portion (discussed previously) being integrally provided on an end portion of the first plate, this raised portion projecting to an outer side in a thickness direction of the first plate from one side face of the first plate, extending beyond the one side face of the first plate in the thickness direction; and wherein the third plate is located such that the rotary tool is positioned above the third plate and the third plate supports a load during the friction stir welding. See claim 2.

Furthermore, it is respectfully submitted that the applied references would have neither taught nor would have suggested such a hollow frame member as in the present claims, having features as discussed previously in connection with claim 2, and, moreover, wherein at an end portion of the second plate, at a side of the end portion of the first plate having the raised portion, the hollow frame member has a further raised portion which projects to an outer side in a thickness direction of the second plate from one side face of the second plate, and extending beyond the one side face in the thickness direction, with this further raised portion adapted to have the rotary tool inserted therein in the thickness direction so as to carry out friction stir welding; wherein the third plate is positioned such that, during the friction stir welding wherein the rotary tool is inserted into the further raised portion, the third plate of the hollow frame member supports a load; and wherein, during the friction

stir welding, material of the further raised portion of the second plate fills any gaps, between the hollow frame member and the another hollow frame member to be welded to the hollow frame member, which exist when the hollow frame members abut each other. See claim 3.

It is respectfully submitted that in the interpretation by the Examiner of the teachings of Mochizuki, et al., the Examiner is inconsistently referencing the thickness direction. That is, the Examiner indicates that the hollow frame member has a raised portion (item 27e) which projects to an outer side in a thickness direction (with respect to item 27c), while also contending that this thickness direction is along a direction perpendicular to plates 27b and 27a. That is, while item 27e extends in a same direction as plates 27b and 27a, the Examiner has used different directions for the thickness direction, when referring to the thickness direction relative to plates 27b and 27a, on the one hand, and 27e, on the other. Using the same frame of reference for the thickness direction, it is respectfully submitted that the combined teachings of the applied references, including Mochizuki, et al., would have neither taught nor would have suggested the presently claimed subject matter, including wherein the hollow frame member has a raised portion which projects to an outer side in a thickness direction of the hollow frame member from one side face of the hollow frame member, extending beyond the one side face in the thickness direction, as in the present claims, and advantages thereof.

Moreover, it is respectfully submitted that the combined teachings of the applied references would have neither disclosed nor would have suggested the structure as in the present claims, including the raised portion projecting to an outer side in the thickness direction, and extending beyond the side face in the thickness direction; or the vertical plate (claim 1) or third plate (claims 2 and 3) and positioning

thereof such that the vertical or third plate supports a load during the friction stir welding. Through use of such vertical or third plate, deformation of the joint region when two members are friction stir welded is minimized, due to forces of the friction stir welding being sustained by the vertical or third plates. See, e.g., page 5, lines 16-20, of Applicants' specification.

Moreover, it is respectfully submitted that the teachings of the applied references would have neither disclosed nor would have suggested the claimed hollow frame member, having aspects as in claims 1-3, and additionally wherein the two recited frame members are friction stir welded to each other. See claims 20-22.

In addition, it is respectfully submitted that the teachings of the applied references would have neither disclosed nor would have suggested other features of the present invention as in the remaining, dependent claims, which have features as discussed previously in connection with claims 1, 2 and 3, and further including (but not limited to) wherein the first plate (or first and second plates) of the hollow frame member respectively have exposed outer faces, with the raised portion (or raised portion and further raised portion) respectively projecting beyond the exposed outer faces in the thickness direction (see claims 6 and 10); and/or wherein the exposed outer faces are exposed during the friction stir welding (see claims 7, 11 and 14); and/or wherein the thickness direction is a direction perpendicular to the exposed outer faces and/or one side face (see claims 9, 12, 13 and 15); and/or wherein various parts of the hollow frame member are made of a same material, as in claims 18 and 19; and/or wherein the third plate extends in the thickness direction (see claim 26).

It is emphasized that through use of the raised portion in combination with use of the vertical or third plate, indentations (deformation and sunken portions) in the friction stir weld joint can be substantially avoided.

Specifically, through use of the vertical or third plate, forces in the vertical direction due to the friction stir welding are absorbed by the vertical or third plate, avoiding deformation of the first and second plates of the hollow frame members and thereby avoiding deformation of the friction stir welded joint.

Furthermore, as described, for example, in the last full paragraph on page 9 of Applicants' specification, by including the raised portion which projects to an outer side in a thickness direction of the hollow frame member (or of the first plate), extending in the thickness direction beyond the side face, if there is a gap between the hollow frame members before welding the gap can be filled with the material of the raised portions, improving the appearance and reducing the amount of putty required in order to provide a planar surface. That is, sunken portions or recesses in the weld bead, due to material filling the gap when there is no raised portion, can be avoided, thereby improving the product formed.

Moreover, by integrally providing the raised portion on the end portion of the hollow frame member, with the raised portion adapted to have the rotary tool inserted therein in the thickness direction so as to carry out the friction stir welding, manufacturing of the structure being friction stir welded can be easily and effectively achieved (for example, the hollow frame member can be made as a single integral member, e.g., by extrusion, with the raised portion, for example, of a same material as a remainder of the hollow frame member), and friction stir welding with the rotary tool being inserted into this integral raised portion can easily and effectively be performed.

Mochizuki, et al. discloses a vehicular body structure 20 (note Fig. 1) constructed by assembling the appropriate number of window-forming materials 21 and wainscot panel-forming material 23 and pole plate-forming material 24 as the roof structure, and floor-forming material 25 and side beam-forming material 26 as

an under frame respectively as occasion demands. Both edge parts of facing inner plates 28a and outer plates 27b are connected by baseboards 27c; and in the hollow parts surrounded by the inner and outer plates 27a, 27b and baseboards 27c, reinforcing ribs 27d are continued in the trussed state.

It is respectfully submitted that Mochizuki, et al. does not disclose, nor would have suggested structure being friction stir welded; and it is respectfully submitted that this reference would have neither taught nor would have suggested such a hollow frame member adapted to be used in friction stir welding, as in the present claims. Moreover, it is respectfully submitted that this reference does not disclose, nor would have suggested, a hollow frame member, having the raised portion which projects to an outer side in a thickness direction of the hollow frame member from one side face of the hollow frame member, the raised portion extending beyond the side face in the thickness direction, and which is provided integrally on the end portion of the hollow frame member, as in the present claims, or the vertical or third plate, as in the present claims. Furthermore, it is respectfully submitted that this reference does not disclose, nor would have suggested, advantages achieved according to the present invention of a hollow frame member having both the third or vertical plate and the raised portion, used in friction stir welding, in avoiding indentations/deformations in the friction stir welded joint utilizing the hollow frame member and thereby avoiding the need for additional processing of filling in the indentations/deformations.

The contention by the Examiner that Mochizuki, et al. shows a raised portion (item 27e in Fig. 2 of this reference) is respectfully traversed. It is respectfully submitted that structure represented by reference character 27e in Fig. 2 of Mochizuki, et al. does not, inter alia, project to an outer side in a thickness direction of the hollow frame member, extending beyond the one side face in the thickness

direction, as recited in the present claims, and it is respectfully submitted that the structure represented by reference character 27e in Mochizuki, et al. would have neither taught nor would have suggested the raised portion as in the present claims.

Furthermore, it is respectfully submitted that Mochizuki, et al. would have neither taught nor would have suggested the vertical or third plate, which supports a load during the friction stir welding (it being emphasized that Mochizuki, et al. does not even disclose friction stir welding of the described structure), much less positioning of this vertical or third plate so as to support a load during the friction stir welding, and advantages achieved thereby.

It is further respectfully submitted that Mochizuki, et al. would have neither disclosed nor would have suggested additional features of the present invention as discussed in the foregoing, and advantages thereof.

It is respectfully submitted that the additional teachings of Midling, et al. would not have rectified the deficiencies of Mochizuki, et al., such that the presently claimed invention as a whole would have been obvious to one of ordinary skill in the art.

Midling, et al. discloses a technique of friction stir welding, wherein the non-consumable probe used in the friction stir welding has a bottom part 23 (shoulder; see Fig. 3) exhibiting a concave surface, while the pin 24 of the probe has an outer surface provided with alternately protruding and recessed parts along its longitudinal axis. See the last full paragraph on page 3. Note also the last full paragraph on page 4. In Figs. 5a-e of this published patent document are displayed schematically in fragmentary perspective views, different types of welds provided by the method and probe including, in Fig. 5c, an overlap weld seam.

Initially, Applicants respectfully traverse the interpretation by the Examiner of the teachings of Midling, et al., and, in particular, the contention by the Examiner that

Midling, et al. teaches that the member has a raised portion which projects "to a thickness direction" of the member from one side face of the member (the Examiner referring to Fig. 5c of Midling, et al.), with this raised portion being a portion adapted to have a rotary tool inserted therein so as to carry out a friction stir welding. As can be seen in Fig. 5c, there is no "raised portion" in Midling, et al. as in the present claims, which projects to an outer side in a thickness direction of the hollow frame member, and extends beyond the one side face of the hollow frame member in the thickness direction, the raised portion being a portion adapted to have the rotary tool inserted therein in the thickness direction to carry out the friction stir welding. As seen in the foregoing in connection with discussion as to the teachings of Mochizuki, et al., and as to the teachings of Midling, et al., it is respectfully submitted that the teachings of these references individually and/or in combination would have neither taught nor would have suggested the raised portion as in the present claims, especially which projects to an outer side in a thickness direction of the hollow frame member from one side face of the hollow frame member and extends beyond the one side face of the hollow frame member in the thickness direction and is provided integrally on the end portion of the hollow frame member, with this raised portion being a portion adapted to have a rotary tool inserted therein in the thickness direction so as to carry out the friction stir welding.

With respect to the rejection under 35 USC 103, it is respectfully submitted that the teachings of Mochizuki, et al. and of Midling, et al. would not have been properly combinable. Thus, it is emphasized that Mochizuki, et al. discloses a body structure of a railway vehicle, and does not disclose use of friction stir welding for fixing the various materials to each other. It is respectfully submitted that one of ordinary skill in the art concerned with in Mochizuki, et al. would not have looked to the teachings of Midling, et al., directed to friction stir welding. In view of the different

technologies involved in each, and different problems addressed in each, it is respectfully submitted that the references are directed to non-analogous arts and are thus not properly combinable under 35 USC 103.

In any event, even if the teachings of these references were properly combinable, it is respectfully submitted that the combined teachings would have neither disclosed nor would have suggested the presently claimed invention, including the raised portion and/or vertical (third) plate, much less positioning of the vertical (third) plate so as to support a load during the friction stir welding, and advantages of these features of the present invention in avoiding deformation/indentations in the friction stir welded joint; and/or other features of the present invention as discussed in the foregoing, and advantages thereof.

Furthermore, emphasizing that Midling, et al. shows a solid plate being friction stir welded, clearly the teachings of this reference, alone or in combination with the teachings of Mochizuki, et al., would have neither disclosed nor suggested the vertical/third plate and location thereof so as to function as set forth in the present claims.

It is again emphasized that the Examiner refers to Item 27e of Fig. 2 of Mochizuki, et al., as a raised portion "which projects to an outer side in a thickness direction" of a hollow frame member. Item 27e in Mochizuki, et al. extends in a same plane as the face of Item 27a in Fig. 2; and it is respectfully submitted that this reference would have taught away from the hollow frame member as in the present claims, including, inter alia, wherein the raised portion extends beyond the one side face in the thickness direction, and wherein the raised portion is a portion adapted to have a rotary tool inserted therein in the thickness direction. That is, if the thickness direction is the vertical direction in Fig. 2 (the vertical direction being the direction

wherein Fig. 2 is at the top of the figure), clearly the structure is not adapted to have a rotary tool inserted in the raised portion in the thickness direction.

The contention by the Examiner in the first full paragraph on page 8 of the Office Action dated July 27, 2007, that Applicants have failed to provide any disclosure within the prior art which would lead one of ordinary skill in the art to believe that the claimed limitations are not taught or suggested, and that Applicants have not provided any evidence that their claimed invention is unexpected and significantly different from the disclosure cited by the Examiner, is noted. It is respectfully submitted that this is an improper test under 35 USC 102 and 35 USC 103. Thus, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness, due to failure to establish that the references would have taught or suggested the claimed subject matter as a whole including various recitations in the claims; and, accordingly, Applicants need not submit evidence of unexpectedly better results. Furthermore, it is respectfully submitted that the burden is on the Examiner to establish, in the first instance, anticipation and/or obviousness; and it is respectfully submitted that Applicants need not establish that disclosure within the prior art would lead one of ordinary skill to believe that the claimed recitations are not taught or suggested.

Contentions by the Examiner in the paragraph bridging pages 9 and 10 of the Office Action dated July 27, 2007, are noted. Avoidance of indentations, deformation and sunken portions is an advantage achieved by the structure of the present invention; it is respectfully submitted that Applicants need not recite such advantages in their claims, where the structure recited provides such advantages.

Applicants respectfully traverse the analysis of Mochizuki, et al., as set forth in the first sentence on page 11 of the Office Action dated July 27, 2007. It is respectfully submitted that the Examiner errs with respect to thickness direction; and

properly construing the thickness direction, this analysis by the Examiner is improper.

The contention by the Examiner that pending claims must be given the broadest reasonable interpretation, is noted. However, such interpretation must be reasonable. It is respectfully submitted that the interpretation by the Examiner with respect to, for example, the raised portion, is not reasonable.

The contention by the Examiner that Middling, et al. discloses a "raised portion" is respectfully traversed. What the Examiner considers to be the raised portion in Fig. 5c of Middling, et al. does not extend beyond said one side face in said thickness direction, and thus the structure of Fig. 5c of Middling, et al., even assuming, arguendo, that such structure were properly combinable with the teachings of Mochizuki, et al., would have neither taught nor would have suggested the presently claimed subject matter, including the raised portion as in the present claims.

The contention by the Examiner in the paragraph bridging pages 13 and 14 of the Office Action dated July 27, 2007, that the references are "relevant to the same field of endeavor, is respectfully traversed. Initially, the question is not that the references are "relevant to" the same field of endeavor, but rather that they are "within" the same field of endeavor. The Examiner has not even contended that the references are within the same field of endeavor.

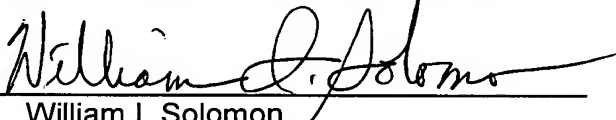
It is noted again that Applicants have requested a three (3) month suspension of action, with payment of the necessary fee therefor. Applicants have the right to submit a supplemental reply during the suspension of action period. See 37 CFR 1.111(a)(2)(ii). Accordingly, it is respectfully requested that the Examiner refrain from acting on the above-identified application until after the close of the suspension period.

In view of the foregoing comments and amendments, and in view of the concurrently filed RCE Transmittal, entry of the present amendments, with a suspension of action of three (3) months and with examination of the above-identified application subsequent to the suspension, is respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 503.35255VX4), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

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